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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CDTP006 D1
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>7/5/2007</u></p> <p>Signature <u>C. Douglas Thomas</u></p> <p>Typed or printed name <u>C. P. THOMAS</u></p>		<p>Application Number 10/039,341</p> <p>Filed 12/31/2001</p> <p>First Named Inventor Thomas</p> <p>Art Unit 2164</p> <p>Examiner Rimell, S.</p>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,947</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p><u>C. Douglas Thomas</u> Signature</p> <p><u>C. DOUGLAS THOMAS</u> Typed or printed name</p> <p><u>408-252-9991</u> Telephone number</p> <p><u>7/5/2007</u> Date</p>		
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: THOMAS
Application No.: 10/039,341
Filed: December 31, 2001
Title: SYSTEM AND METHOD FOR
MONITORING DOMAIN NAME
REGISTRATIONS

Attorney Docket No.: CDTP006D1
Examiner: RIMELL, S.
Group: 2164

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage, as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 5, 2007.

Signed: C. Douglass Thomas

Printed Name: C. Douglass Thomas

PRE-APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Office Action, the Examiner rejected claims 13-27 under 35 USC § 112, first paragraph; and rejected claims 1-27 under 35 USC § 102(e). These rejections are fully traversed below.

Claims 1-27 and 31-33 remain pending in the application.
Reconsideration of the application is respectfully requested based on the following remarks.

REJECTION OF CLAIMS 13-27 UNDER 35 USC § 112, FIRST PARAGRAPH

In the Office Action, the Examiner rejected claims 13-27 under the first paragraph of 35 USC § 112 as allegedly failing to comply with the written description requirement. Applicants respectfully disagree.

The Office Action alleges that the former amendments to claim 13 are not supported by the specification as required by the written description requirement. While claim 13 was previously amended to recite “said searching (b) identifies one or more registrations of domain names that are **identical** to the name to be monitored, and … said searching (b) identifies one or more registrations of domain names that are **variants** of the name to be monitored” (emphasis added), such limitations are disclosed in the specification. As such, these amendments cannot be considered to be “new matter.” Applicant notes, for example, that Figs. 8C and 9 and accompanying text in the specification clearly support the ability to search not only identical names but also variants of the names. As one example, page 21, line 30 to page 22, line 23 of the specification regarding Fig. 8C clearly describes monitoring not only domain names but also similar domain names. As another example, with regard to Fig. 9, page 23, lines 18-20 of the specification clearly states that “…a domain **variation** is selected 908 from the domain space. In other words, the domain space includes various domain **variations** associated with the primary domain.” Accordingly, it is respectfully submitted that claim 13 is fully supported by the original specification in a manner that reasonably conveys to one skilled in the art that inventor has possession of the claimed invention. Likewise, dependent claim 14-27 are also completely supported in this regard.

Thus, it is respectfully requested that the rejection of the claims 13-27 under 35 USC § 112, first paragraph, be withdrawn.

REJECTION OF CLAIMS 1-12 AND 31-33 UNDER 35 USC § 102

In the Office Action, the Examiner rejected claims 1-12 and 31-33 under 35 USC § 102(e) as being unpatentable over Schneider, U.S. Patent No. 6,338,082. Applicants respectfully disagree.

Schneider describes a method, product and apparatus for requesting a network resource. According to Schneider, "[w]hen a network resource request having a domain name is received, it is determined whether the network resource can be located including determining whether the domain name is resolvable. Rather than displaying an error message or processing a search request in response to determining that a network resource can not be located or of an unresolvable domain name, the domain name can instead be redirected to a registration service where the unresolvable domain name is automatically used to perform a registration request and determine domain name availability. When the domain name is not available for registration, domain name registrant information is provided. However, when the domain name is determined available, a registration form is provided." See Abstract.

In contrast, claim 1 pertains to a computer-implemented method for monitoring domain name registrations. In particular, a request to monitor a name is received. Then, a database of domain name registrations can be searched to identify one or more registrations of domain names that match the name being monitored. The requestor of the monitoring can then be notified of the identified one or more registrations. The searching and the modifying are periodically automatically performed so as to provide monitoring for domain name registrations that match the name being monitored.

On page 3 of the Office Action, the Examiner references Fig. 3a of Schneider and its discussion at column 12, line 57 through column 13, line 25. At block 314 of Fig. 3a, a determination of whether a domain name is available is made. If the domain name is already registered, then it is not available and a record from the WHOIS database is displayed. First of all, it should be noted that the processing illustrated in Fig. 3a is performed on user request after a user

input has been provided. In contrast, claim 1 is periodically and automatically performed to provide monitoring function to identify domain name registrations that match the name being monitored. The processing in Fig. 3a of Schneider does not perform a monitoring process. Moreover, the processing in Fig. 3a of Schneider is also not taught or suggested as being periodically and automatically performed. Any searching using Schneider would be at a user request and thus neither automatic nor periodic. If anything, Schneider would teach against any periodic and automatic monitoring as recited in claim 1.

Claim 1 clearly recites that after a request to monitor a name has been received, (i) “searching” a database of domain name registrations to identify one or more registrations of domain names that match the name being monitored and (ii) “notifying” the requestor of the identified one or more registrations can be periodically automatically performed. With Schneider, the WHOIS database is searched once in response to a user request. Schneider thus lacks any teaching or suggestion to periodically and automatically search a name and notify so as to provide a monitoring ability.

Accordingly, it is submitted that claim 1 is patentably distinct from Schneider.

Claim 11, similar to claim 1, pertains to the computer-implemented method for monitoring domain name registrations. In monitoring domain name registrations, when one or more registrations are identified as matching a name being monitored, the method further operates to send warning messages to the offending registrants. In this regard, claim 11 recites: “sending warning messages to registrants of the identified one or more registrations.” On page 4 of the Office Action, the Examiner points to block 318 of Fig. 3a which displays a record from the WHOIS database. More particularly, in response to a registration request, if the domain name 306 is determined not to be available in step 314, then a record from a corresponding WHOIS database is retrieved and displayed at step 318. Schneider, col. 12, lines 57-67. Schneider is merely notifying the user of the method in Fig. 3a that a domain name is not available. The user is

not a registrant, and the WHOIS record returned to the user is not a warning message as recited in claim 11. In contrast, claim 11 is sending warning messages to registrants associated with the one or more identified registrations, not the requestor who is inquiring as to the availability of the domain name.

Hence, it is submitted that claim 11 is patentably distinct from Schneider.

In the Advisory Action, the Examiner newly alleges that the requestor and the registrant can perhaps be the same person. However, according to claim 11, in operation (c) the requestor is notified of the identified one or more registrations, and in operation (d) registrants of the identified one or more registrations are sent warning messages. Beyond noting that the requestor and the registrants are different, it should be noted that operation (c) and operation (d) of claim 11 provide different information to requestor and registrants, thus further distinguish the two. Furthermore, Schneider lacks any teaching or suggestion for sending warning messages to registrants.

Based on the foregoing, it is submitted that claims 1 and 11 are patentably distinct from Schneider. In addition, it is submitted that claims 2-10, 12 and 31-33 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider.

Thus, it is respectfully requested that the Examiner withdraw the rejection of the claims 1-12 and 31-33 under 35 USC § 102(e).

SUMMARY

It is submitted that claims 13-27 satisfy the written description requirement of 35 USC § 112, first paragraph. In addition, it is submitted that claims 1-12 and 31-33 are patentably distinct from Schneider. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.